

### REMARKS

Favorable reconsideration of this application is requested in view of the following remarks.

Claims 2, 3, 7 and 8 are canceled by this amendment. Thus, Claims 1, 4-6, 9 and 10 are pending, with Claim 1 being the only independent claim.

Claim 1 is amended to include the subject matter previously defined by Claims 2 and 3.

The Official Action objects to the Specification; rejects Claims 1-10 under 35 U.S.C. § 112, second paragraph; rejects Claims 1, 2, 5-7 and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,200,053, hereinafter *Asami*; rejects Claims 1, 5, 6 and 10 under 35 U.S.C. § 102(b) as being anticipated by JP05-84236B, hereinafter *Iwase*; rejects Claims 3, 4, 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over *Asami*; and rejects Claims 2-4 and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over *Iwase*.

#### Objections

On the top of page two of the Official Action, an issue is raised regarding the Abstract. The Abstract is amended to place it within 150 words and to be a single paragraph, thereby addressing that issue.

#### Rejections under 35 U.S.C. § 112

On the middle of page two of the Official Action issues are raised regarding Claims 1 and 5. Claims 1 and 5 are amended thereby addressing those issues.

Rejections under 35 U.S.C. § 102(b)

Claims 1, 2, 5-7 and 10 are rejected as being anticipated by *Asami*. As shown in Fig. 1 of *Asami*, the pen 1 includes ink 2, a ball 3, a tip 4, an ink container 6, and a connecting member 5 that connects the container to the tip 4. At the end of the container is a follower 7.

Claim 1 presently defines a combination of features including features directed toward an ink-storing member that comprises a multilayer structure comprising an organic high molecular compound layer that is constituted of an organic high molecular compound and an inorganic compound layer.

As set forth in the Official Action, it is understood that *Asami*'s follower 7 is relied upon for a disclosure of an inorganic compound layer of an ink-storing member. It is understood that the Examiner assumes that as the follower 7 moves within the ink container 6, that a layer of the follower 7 is coated on the inside of the container 6, thereby providing an "inorganic compound layer" as defined by Claim 1. However, that idea is flawed in at least two ways. First, there is no disclosure in *Asami* that the follower 7 coats the inside of the container 6, and it is known otherwise in the art, i.e., that the follower 7 would not coat the inside of the container 6. In other words, it is not believed that a follower 7 layer is created. Second, even if the follower 7 were to somehow coat the inside of the container 6 it would not form a layer of an ink storing member because the layer would not act to store ink. Rather, it would coat the part of the container that the ink has vacated. For at least those reasons, *Asami* does not disclose an inorganic compound layer as defined by Claim 1.

Claims 1, 5, 6 and 10 are rejected as being anticipated by *Iwase*. *Iwase* discloses a writing instrument having a barrel 1 in which a silver 10 filled with an ink is provided. The barrel 1 is disclosed as being formed of a composite material 2 made up of a label paper 3a made of kraft paper having aluminum foil on the outer surface, liner papers 3b, 3c, a polyethylene layer 4 having an aluminum vapor-deposit layer 5, and a polyester layer 7 as the innermost layer.

To better define over the disclosure in *Iwase*, Claim 1 is amended to include certain subject matter previously defined by Claims 2 and 3 directed toward the inorganic compound having a parallel light transmittance of 50 % or more, and the inorganic compound layer comprising inorganic compounds selected from a group consisting of SiO, SiO<sub>2</sub>, Al<sub>2</sub>O<sub>3</sub>, CaF<sub>2</sub>, SnO<sub>2</sub>, CeF<sub>3</sub>, MgO, ZnO, TiO<sub>2</sub>, MgAlO<sub>4</sub>, In<sub>2</sub>O<sub>3</sub>, SrCu<sub>2</sub>O<sub>2</sub>, CuInO<sub>2</sub>, CuInSe<sub>2</sub> and ITO. That subject matter is not, as recognized in the Official Action, disclosed by *Iwase*. For at least that reason, the anticipatory rejection of Claim 1 is deficient and should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

The subject matter of Claims 3, 4, 8 and 9 is rejected as being obvious in view of *Asami*.

Certain subject matter defined by previous Claims 2 and 3 is now included in Claim 1. That subject matter is directed toward an inorganic compound layer having parallel light transmittance of 50% or more, wherein the inorganic compound layer comprises inorganic compounds selected from the group consisting of SiO, SiO<sub>2</sub>, Al<sub>2</sub>O<sub>3</sub>, CaF<sub>2</sub>, SnO<sub>2</sub>, CeF<sub>3</sub>, MgO, ZnO, TiO<sub>2</sub>, MgAlO<sub>4</sub>, In<sub>2</sub>O<sub>3</sub>, SrCu<sub>2</sub>O<sub>2</sub>, CuInO<sub>2</sub>, CuInSe<sub>2</sub> and ITO.

The Official Action proposes that it would have been obvious for one skilled in the art to modify *Asami*'s disclosure to include the inorganic compounds defined by Claim 3. However, even if that were the case, *Asami* still would not disclose the claimed subject matter directed toward an organic compound layer and an inorganic compound layer. For example, the follower 7 does not disclose an inorganic compound layer of a multilayer ink storing member. The follower 7 is positioned behind the ink that is contained in the container 6, and it is understood that the Examiner does not consider the follower in and of itself to disclose the claimed inorganic layer. Rather, it is proposed in the Official Action that the inorganic layer is created when the follower 7 slides along the container 6 allegedly depositing a layer on the inside of the container 6. However, there is no disclosure in *Asami* that a layer of the follower 7 is left behind, and even if there were a layer of the follower 7 left behind, that layer would not form a layer of a multilayer structure of an ink-storing member at least because it would serve no function relating to retention of the ink. It seems that the Examiner is relying on a rather tortured interpretation of *Asami* to find disclosure or suggestion of all the features of present Claim 1.

Claims 2-4 and 7-9 are rejected as being obvious in view of *Iwase*. As noted above, the subject matter of Claims 2 and 3 is now included in Claim 1. It is proposed in the Official Action that it would have been obvious to select optimum workable ranges to arrive at the claimed subject matter. However, *Iwase* specifically discloses a composite structure made of label paper 3a that is made of kraft paper having aluminum foil on the outer surface, liner papers 3b, 3c, a polyethylene layer 4 coated on the inner surface of the liner paper 3c, a polyester layer 6 having an aluminum vapor-deposit layer 5, and another polyester layer 7 as the innermost

layer. *Iwase* specifically discloses each layer's position and material. *Iwase*'s disclosed compound layer does not include the inorganic compounds defined in amended Claim 1. Further, there is no direction in *Iwase* to include the inorganic compounds defined by the claims.

Therefore, a skilled person presented with the *Iwase* disclosure would have had to be motivated to replace the disclosed components of *Iwase* with different claimed compounds, not simply vary ranges, to arrive at the claimed subject matter. There would not have been motivation to use different materials than those disclosed by *Iwase* to arrive at the subject matter defined by the claims absent some outside direction to do so. It has not been shown where or how *Iwase* would have provided such direction.

Further, *Iwase* does not necessarily provide and certainly does not teach that the ink-storing member has a parallel light transmittance of 50 % transparency as defined by the claims. For example, *Iwase* discloses aluminum layers, and as illustrated in Table 1, example A-5 has a polypropylene layer and an aluminum layer that together produce 40 % transparency. Therefore, it is apparent that the claimed transmittance is not necessarily obtained. Even further, as the layer 3a is made of kraft paper and aluminum foil it seems that the compound layer is more likely non-transparent. Therefore, it would not be obvious to select inorganic compounds that would result in at least 50 % transparency and deviate from the intended design of *Iwase*.

For at least the reasons stated above, it would not have been obvious to a skilled person in the art to modify either *Asami* or *Iwase* to include the subject matter defined previously by Claims 1-3, and Claim 1 is therefore allowable.

Claims 4, 5, 9 and 10 are allowable at least by virtue of their dependence from allowable Claim 1, and also because they define subject matter that defines over the cited documents. For example, Claim 4 defines that the ink-storing member for a writing instrument has an oxygen permeability of  $10 \text{ cc/m}^2 \cdot \text{Day} \cdot \text{atm}$  or less at  $24^\circ\text{C}$  and 65 %RH and a steam permeability of  $10 \text{ g/m}^2 \cdot \text{Day} \cdot \text{atm}$  or less at  $40^\circ\text{C}$  and 90 %RH. The Official Action proposes that it would have been obvious for a skilled person to select the claimed compounds to arrive at that claimed subject matter. However, there is no disclosure in the cited documents that would have led a skilled person to desire an oxygen permeability of  $10 \text{ cc/m}^2 \cdot \text{Day} \cdot \text{atm}$  or less at  $24^\circ\text{C}$  and 65 %RH and a steam permeability of  $10 \text{ g/m}^2 \cdot \text{Day} \cdot \text{atm}$  or less at  $40^\circ\text{C}$  and 90 %RH. Absent a desire to achieve such results, there would have been no motivation to select the claimed inorganic compounds that would produce such results. Should that rejection be maintained, it is requested that it be shown where or how the cited documents disclose a desire to achieve the qualities defined in Claim 4.

### Conclusion

For at least the reasons stated above, it is requested that all the rejections be withdrawn and that this application be allowed.

Should any questions arise in connection with this application, or should the Examiner feel that a teleconference would be helpful in resolving any remaining issues pertaining to this application, the undersigned requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL PC

(INCLUDING ATTORNEYS FROM BURNS DOANE SWECKER & MATHIS)

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